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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,690	04/05/2001	Joseph Harbaugh	6994-1	4205

7590 07/27/2006

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EXAMINER	
SMITH, TRACI L	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/826,690	HARBAUGH, JOSEPH	
	Examiner	Art Unit	
	Traci L. Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to papers filed on May 3, 2006.

Claims 1, 3-9, 11-13 and 15-20 have been amended.

Claims 1-22 are pending.

Claims 1-22 are rejected.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim teaches the limitation of "identifying a pool of test takers who have - a second academic institution...but do not have acceptable qualifications. Examiner is unable to identify how the applicant intends to find out which students have applied to other schools and have not received offers. The examiner is aware that institutions are able to purchase names and scores for test takers from testing program, however, whether a student has been admitted elsewhere is not reported by the testing programs. How does the present invention identify those student who have applied to a second institution. The disclosure teaches identifying qualifications of students how wouldn't

not normally meet most law school requirements but does not disclose how to identify that the student has applied to the second institution. The examiner notes that the affidavit submitted by Paul Shelton further indicates that applicants program requests reports with LSAT scores below admissible levels and not applied to applicants school(first institution) but nothing directed towards application status at a second institution. The examiner notes a students application status includes not only what level they have been admitted at but also whether or not they have even applied.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 13 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by www.gradcollge.swt.edu (any linkage on(2000): *March 4, 2000).

5. As to claims 1 and 13, swt.edu teaches a method for admitting students to a university, who fall below the minimum requirements of standardized tests and GPA's, to the institution while setting **conditions** on the admission opportunity. Once a student is meets all the requirements of their conditional admittance they are giving an unconditional admission status.(P. 7 l. 9-10, 29-25 and 37-40). **The classes being taken do not count towards credit for a program(Pg. 14 ¶ E and Pg. 17 ¶ C)** As to the limitation getting a pool of standardized test takers the examiner takes official notice that it is old and well known in the art of admissions to purchase or gain access to a list of students in a particular category in order to target enrollment. The examiner draws

on her experience as an admissions counselor from August 1999 to May 2004 that colleges and universities routinely purchase student names and test scores from testing organizations such as SAT in order identify students in an academic/testing category in which the school wishes to target enrollment. This practice was taking place long before the examiner was in the field in 1999.

6. As to claim 20 swt.edu teaches a GRE score of 900 or above for regular admission; conditionally admitted even though you may not meet the minimum requirements.(Pg. 7 l. 10, 32-33)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-4, 7, 14-15 and 18-19 rejected under 35 U.S.C. 103(a) as being unpatentable over www.swt.edu as applied to claim1, 13 and 20 above, and further in view of Karen W. Arenson; *New York Times*, "Opponents of a Change in CUNY Admissions Policy Helped Pass a Compromise Plan"; November 24, 1999.

1. As to claims 2-3 and 14-15 swt.edu teaches a method of conditional admittance using GPA's but fails to teach the standardized test range. Arenson teaches the use of standardized test scores to identify students who don't qualify for regular admission.(Pg 2 ¶ 7-8). It would have been obvious to combine the standardized test scores to identify

students who would fall into conditional admittance, as test scores are a normal index score to use when considering students for regular admissions. As to the limitation of scoring and calibrated grading by applicants own admission this is a practice that is old and well known in the art therefore does not patentably distinguish it from the prior art.

9. As to claim 4, swt.edu teaches the method of conditional admission but fails to teach the satisfactory criteria for at least one examination. Arenson teaches a method of placement tests to determine level of work(Pg. 2 ¶ 7). It would have been obvious to set satisfactory criteria for the examinations so as to have a guide to identify a students progress or success indicator.

10. As to claims 7 and 18, swt.edu teaches conditions for which admission is based on, however it fails to teach instruction environment. Arenson teaches enrolling students in remedial classes on the senior campus(Pg. 2 ¶ 8). It would have been obvious to combine remedial classes into the main campus program so as to provide the conditionally admitted students with the skills they would need to meet the satisfactory requirements and complete regular level courses.

11. Claims 5-6, 8-9, 16-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu and Arenson as applied to claims 2-4, 7-8, 14 and 18-19 above, and further in view of US Patent 6, 146,148, Nov. 14 2000, Stuppy.

12. As to claims 5 and 16 Arenson fails to teach a method of instruction as condition of admittance but fails to teach distance instruction. Stuppy teaches a method of automated instruction creating a student workbook(C.1 l. 67, C. 2 l. 1, 6). It would have

been obvious to combine the conditional instruction with the technology of distance education to make it more cost effective and easily accessible.

13. As to claims 6 and 17 Arenson teaches a method of instruction for conditionally admitted applicants but fails to teach an electronic method for delivering instruction. Stuppy teaches electronically generating instructional material(C. 2 l. 3-5).

14. Stuppy further teaches collecting student data in response to instructional material(C. 2 l. 7-8).

15. Stuppy also teaches collecting student data from student to teacher.(C. 2. l.20-21). It would have been obvious to combine the technology used by Stuppy in Arenson' instruction method so as to conserve time and money.

16. As to claims 8 and 19 Arenson fails to teach remote online instruction. Stuppy teaches instructors teaching a plurality of students at different arrangements in completely different locations.(C. 5 l. 15-16).

17. Stuppy further teaches teacher and student participation online(C. 5 l.21-22)

18. It would have been obvious to combine the online technologies with the teachings of Arenson for a more interactive, accessible and cost-effective instructional environment.

19. As to claim 9 Arenson fails to teach a method of administering and grading an examination online. Stuppy teaches a method of mastery testing to determine the skill of students during a later session with results stored and used on the server(C. 7 l. 41-46). It would have been obvious to combine the electronic technologies of Stuppy to the

teachings for Arenson to have a method of assessing student level in an efficient and accessible manner.

20. As to claim 21 swt.edu teaches a paper method of admitting applicants conditionally. Swt.edu fails to teach an electronic method of admitting the students and completing the conditions of the admission electronically. Stuppy teaches an automated assessment and testing through a multimedia interface and answers questions electronically. Tests are scored and analyzed by computer then utilized to generate a program suited for the student. (C. 4. l. 40-56)

21. It would have been obvious to combine the online teachings of Stuppy with swt.edu to advance the process with the use of technology as well as a more accessible and efficient process.

22. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu and Arenson as applied to claims 2, 4, 7, 14 and 18-19 above, and further in view *New Models to Assure Diversity, Fairnes and Appropriate Test Use in Law School Admissions.* A Publication of the Law School Admission Counsel; October 1999(hereafter referred to as LSAC).

23. As to Claim 10 swt.edu teaches an admission compiling process but it fails to teach the method with the use of LSAT scores. LSAC teaches a method of using LSAT scores as a part of the admission decision making process.(Pg. 14 ¶ 7, 'Academic Factors'). It would have been obvious to combine the teachings of LSAC to swt.edu since swt.edu's process was for general graduate programs and the LSAT a specific assessment test for Law schools.

24. As to claim 11 Arenson teaches a method of using test scores and GPA's in the admissions decision process but fails to the process using the LSAT specifically. LSAC teaches a method of using the LSAT as an admissions criteria(Pg. 14 ¶ 6-7). It would have been obvious to combine the teaches of Arenson' admissions process with that of the LSAC as applicants applying to Law school would take the Law School Assessment Test(LSAT) as part of the requirements for admission. Examiner notes an enrolled student has already been admitted to the university, as se forth in claim 1, therefore if they are enrolled they can't be part of a "program for admissions".

25. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu as applied to claims 1, 13 and 20 above, and further in view of US Patent 6, 088, 686, July 11, 2000; Walker et al.

26. As to claim 22 swt.edu teaches a method for determining a students qualifications for admissions but it fails to teach an electronic computer process for completing the method. Walker et al teaches a method for electronically submitting an application and performing the steps of the acceptance process.(C. 2. l. 1-8) It would have been obvious to combine the teaches of Walker into swt.edu as they are both the automation of an application review process.

27. Walker et al., further teaches program requirements for new or existing customers that are systematically ranked(A, B, C and D) and recommended decision and required credit policies are appropriately completed(C. 6 l. 45-58). It would have been obvious to combine the teachings of Walker with swt.edu so as to have codes

attached to the required admissions criteria data so a computer program can read and process the information.

28. Walker continues to teach a method of enrolling the applicant for the loan which they have been approved for as an acceptance of the offer and enable the participation in the program (C. 8 l. 51-55; 67-68 & C. 9 l. 1-2). It would have been obvious to combine the enrollment acceptance of Walker with swt.edu so that both the school and the student have an agreement of the admissions condition and are able to begin the course requirements set forth by the admission status. Examiner further notes that the step of making an old method (submitting paper applications) into an automated process does not patentably distinguish itself over the prior art of record.

Response to Arguments

29. Applicant's arguments filed May 3, 2006 have been fully considered but they are not persuasive.

30. As to applicants arguments against the rejection of claims 1, 13 and 20 with regard to the limitation of "not initially applied to the first institution". The examiner notes that this inherent when doing a search for admissible students to an institution. Why would a university or school wait time, money and energy on students who have already applied to the institution. The goal of the pool of candidates is to identify new candidates not candidates the institution is already aware of. Furthermore, applicant is arguing that the reference fails to teach the students as not being admitted to any other institutions, this argument is moot, as applicant has deleted this limitation from the

claims. As to applicants arguments regarding the rejections under 35 USC 103. The applicant is arguing non-obviousness for combining the references. The applicant points to affidavits which alledge secondary considerations of long felt need/unsolved need as well as commercial success. The examiner notes that information produced in the affidavits do not provide satisfactory evidence/proof of either commercial success or long felt need unsolved. As to applicants arguments regarding commercial success. Applicants have shown that the method has been licensed to a two law schools, but not that it has successfully identified students who will perform better than higher test scorers in the actual law program in which applicant is making an argument . Furthermore, the mere licensing to two schools is insufficient to show nexus between the "merits of the invention and the licenses," and thus did not establish secondary consideration of commercial success;. An affidavit or declaration under 37 CFR 1.132 has minimal evidentiary value on the issue of commercial success if there is no nexus or connection between the sales of the article in which the design is embodied and the ornamental features of the design. Avia Group Int 'l Inc. v. L.A. Gear, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988).

31. In order to show long felt need an applicant need to factually identify that the problem has been attempted to be solved and that has gone unsolved in the past. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on

the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem.

32. As to applicants arguments that the students in the abbreviated program are not enrolled at the institution, the examiner respectfully disagrees. The examiner notes applicants amendments to do not teach the limitation of "Not being enrolled". If a student is taking a course at the institution the student is enrolled regardless if the class is for credit towards a program or not. Furthermore, the examiner notes applicants disclosure would not support the addition of a limitation of "not enrolled" as applicants disclosure teaches the student being enrolled. The examiner points to Pg. 7 l. 21-22 that states...enrolled test takers remain enrolled.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS

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